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Appl. No. 09/736,364

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REMARKS/ARGUMENTS

Applicant requests the Examiner to reconsider and allow this application in view of the claim amendments and the following remarks.

Double Patenting

In response to the rejection of claims 33-63 under the judicially created doctrine of double patenting over claims 1-32 of applicant's already-issued U.S. Patent No. 6,507,823, applicant is filing the attached Terminal Disclaimer without prejudice.

Claim Rejections - 35 USC §§102, 103

Claims 33-63 stand provisionally rejected under 35 USC 102(e) as being anticipated by copending application no. 09/739,786. However, the rejection is not correct because application serial no. 09/739,786 is not "prior art" to this case. This case claims the benefit of priority from application serial no. 08/529,216 filed 9/15/95. The effective filing date of this case is thus before the effective filing date of applicant's application serial no. 09/739,786.

The Examiner has also rejected all claims as being anticipated by or obvious in view of Shavit US 4,799,156. Shavit teaches an Interactive market Management System for processing business transactions between a plurality of independent users including a plurality of sellers and buyers and financial institutions. See Abstract for example. Shavit aims to provide a B2B (Business to Business) solution which in essence aims at providing a secure system for interactive on-line electronic communications and

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processing of business transactions between a plurality of independent users over an interactive network.

Shavit says the following about his terminals:

Various types of remote terminals may be utilized such as dumb terminals 68, 70 (e.g., ASCII terminals) which provide terminal access to the system 50 without any local processing capability, or remote intelligent terminals 62, 64 such as a personal computer 62, and a personal computer 64 including a mass storage device 66 (e.g., an International Business Machines personal computer, or a 327x terminal) for storage of a remote data base. Additionally, the remote sites may comprise a remote computer system 56 through which operators communicate via terminals 58, 60, as shown, or the remote site may comprise an automatic computer system 52, 54 which may include a mass storage device 53, (e.g., magnetic hard disk) for storage of a remote data base.

In contrast, applicant has amended each of his pending claims to require the terminals to be automatic teller machine terminals. The claimed invention aims to provide access to products and services to single users of a Bank or FI on bank network and existing infrastructures such as ATM's. The invention allows one to introduce products and services to users using EXISTING infrastructure by allowing vendors to piggyback on the bank's network to offer their P and S to existing bank ATM users.

In contrast, Shavit requires a whole new infrastructure has to be created. In Shavit each user needs to purchase or otherwise provide a special terminal; adapted to access communication links and the system. See abstract. In applicant's invention as now claimed, in contrast, each user does not need a purchase terminal, since the ATM is a

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bank terminal which is used as opposed to an individual terminal. Thus there is no infrastructure or hardware cost for the user. The business principle in my invention is to use existing bank service terminals such as ATMs.

As to page 3, the examiner cannot compare a Shavit Terminal to an ATM. Firstly an ATM is not user owned as a Shavit terminal. Furthermore, the Shavit patent is focused on providing a business solution between members on an industry (Col 2 lines 9-15). In contrast, an ATM (Automated Teller Machine) is focused on meeting people's cash requirements on a personal banking basis. In contrast, the claimed invention focuses on utilizing an existing ATM infrastructure and adding a vendor database with products and services so that users may use the same terminals used in withdrawing cash to buy products and services from the ATM. Therefore it cannot be deemed a mere label difference between the remote data terminals. The examiner is broadening the meaning of ATM beyond reasonable meaning, ATM stands for Automated Teller Machine, therefore it would not apply to someone skilled in the art to have it used in an "obvious" manner.

The Examiner cites Hale as allegedly making it "obvious" to modify Shavit to use bank service terminals. However, Hale in fact teaches directly away from such a combination. The Examiner cites Hale's recognition at col. 1, line 33-34 that ATM terminals can be used for "cash deposits and/or withdrawals." But in the very next sentence, Hale states that "In contrast with the above, the present invention provides a

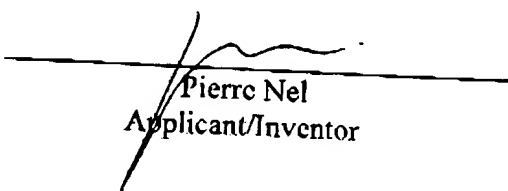
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system for unifying the handling of the above recited financial transactions along with certain personal activities of a user of the system through the use of a user-friendly, pocket-sized terminal." (col. 1, lines 41-44, emphasis added).

All outstanding issues have been addressed and this application is in condition for allowance. Should any minor issues remain outstanding, the Examiner should contact the undersigned at the telephone number listed below so they can be resolved expeditiously without need of a further written action.

Respectfully submitted,

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